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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/665,413

09/22/2003

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EXAMINER

DOAN, TRANG T

ART UNIT

PAPER NUMBER

2131

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
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3 MONTHS

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/665,413 | INOTANI ET AL. | |
| | Examiner | Art Unit | |
| | Trang Doan | 2131 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-8 are pending in this application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 1, 3 and 7-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claim 1 recites the limitations "the control information and the fixed value" in lines 4 and 8. There is insufficient antecedent basis for these limitations in the claim.
5. Claim 3 recites the limitation "the copyright information" in lines 4 and 8. There is insufficient antecedent basis for this limitation in the claim.
6. Claim 7 recites the limitations "the control information and the fixed value " in lines 4 and 8. There is insufficient antecedent basis for these limitations in the claim.
7. Claim 8 recites the limitations "the control information and the fixed value " in line 7, page 21 and line 2, page 22. There is insufficient antecedent basis for these limitations in the claim.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claim 8 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claim 8:

Claim 8 recites "a computer data signal embodied in a carrier wave and representing a sequence of instructions, which executed by a computer included in an information output apparatus, the instructions cause the computer to function as: a generating device for generating output information; an output device for generating and outputting information packets containing the generated output information and the control information used for processing the generated output information outside; and an output control device for controlling the output device in such a manner as to output the information packets containing the fixed value information having a fixed value preset in place of the output information when the output information is not generated by the generating device". Claims that recite nothing but physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Therefore, claim 8 is rejected for reciting non-statutory subject matter.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-2 and 4-8 are rejected under 35 U.S.C. 102(e) as being anticipated by

Muraki et al. (US 6904403) (hereinafter Mura).

12. Regarding claim 1, Mura teaches an information output apparatus comprising; a generating device for generating output information (Mura: see figure1, column 7 lines 50-60 and column 8 lines 18-19); an output device for generating and outputting information packets containing the generated output information and the control information used for processing the generated output information outside (Mura: see figure 1 items 4 and 5, column 7 lines 50-60, column 8 lines 18-26 and column 12 lines 23-25); and an output control device for controlling the output device in such a manner as to output the information packets containing the fixed value information having a fixed value preset in place of the output information when the output information is not generated by the generating device (Mura: see figure 7, column 8 lines [27-39 and 46-49]).

13. Regarding claim 2, Mura teaches an encryption device for encrypting the output information (Mura: column 13 lines 2-9); and a prohibition device for prohibiting the execution of the encryption process of the encryption device for the fixed value information when the output information is not generated by the generating device (Mura: column 16 lines 34-45).

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14. Regarding claim 4, Mura teaches wherein: the output information is audio information and the fixed value of the fixed value information is zero (Mura: see Abstract section).

15. Regarding claim 5, Mura teaches wherein: the control information is sync information used to form the synchronous state of the information packets at the output destination (Mura: see figure 10, column 3 lines 44-61).

16. Regarding claim 6, Mura teaches wherein: the information packets are output through a serial bus conforming with IEEE (Institute of Electrical and Electronic Engineers) 1394 Standard (Mura: see figure 1 item 13, column 8 lines 12-17).

17. Regarding claim 7, this claim has limitations that is similar to those of claim 1, thus it is rejected with the same rationale applied against claim 1 above.

18. Regarding claim 8, this claim has limitations that is similar to those of claims 1 and 7, thus it is rejected with the same rationale applied against claims 1 and 7 above.

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mura as in view of Makino (US 2003/0026420) (hereinafter Makino).

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21. Regarding claim 3, Mura does not explicitly disclose an acquisition device for acquiring the copyright information for the output information, wherein: the encryption device encrypts the generated output information when the acquired copyright information indicates that the generated output information should be protected by the copyright. Makino teaches the encryption device encrypts the generated output information when the acquired copyright information indicates that the generated output information should be protected by the copyright (Makino: paragraphs [0020 and 0037]). Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to combine the teaching of Makino into the method of Mura to add copyright information is subjected to encryption. The ordinary skilled person would have been motivated to have applied the teaching of Makino into the system of Mura to add copyright information is subjected to encryption, so that to ensure or strengthen the author's right in copyright protection with respect to audio data and picture data. Therefore, it is possible to reliably avoid unauthorized copying of media in personal computers over the Internet (Makino: paragraph [0044])

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trang Doan whose telephone number is (571) 272-0740. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Trang Doan
Examiner
Art Unit 2131

T.D.
01/29/2007

CHRISTOPHER REVAK
PRIMARY EXAMINER

